

Attorney Docket: Beiersdorf 617

CONDITIONAL PETITION FOR EXTENSION OF TIME

If any extension of time for this response is required, Applicants request that this be considered a petition therefore. Please charge the required fee to Deposit Account No. 14-1263.

ADDITIONAL FEES

Please charge any further insufficiency of fees, or credit any excess to Deposit Account No. 14-1263.

REMARKS

Claims 11-40 were pending. Claims 11 and 23 have been amended and new claim 44 has been added. No amendment adds new matter.

The Newly Amended Claims do not Recite a Routinely Optimizable Variable

Claim 11 has been amended to recite that the cosmetic formulation is specifically a stabilized emulsion having fixed ratios of (a) the sum of component I and II, to (b) component III. This ratio is similar to that included in the Rule 116 amendment that Examiner did not enter. Examiner's rationale for not considering the newly added limitation is discussed below, and also applies to the instant amendment.

The previous Rule 116 amendment filed on 26 February 2004 included an amendment to the main claim that was directed to a quantitative relationship in the form of a ratio between the neutralized esters of monoglycerides and/or diglycerides and the sorbitan esters. This ratio has been modified, but the legal issue is the same. This amendment is supported in the specification on page 8. Applicants assert that this ratio is sufficient to overcome the rejections because none of the references individually, or in combination even remotely allude to this relationship as being significant. Therefore, it was concluded that under the rule of *In re Antonie*, this ratio could not be considered the result of routine optimization, and was sufficient to overcome the prior art rejections.

In the Advisory Notice Examiner commented on the amendment by stating that she disagreed because "the recognized result in the case is the stability of the emulsion." It is

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respectfully submitted that this rationale does not seem to address the issue and is not sufficient to maintain the rejection.

The issue centers on whether the added claim element is a variable or parameter that may be considered to result from mere routine optimization. MPEP § 2144.05; *A particular parameter must first be recognized as a result-effective variable, i.e., a variable which achieves a recognized result, before the determination of the optimum or workable ranges of said variable might be characterized as routine experimentation. In re Antonie*, 559 F.2d 618, 195 USPQ 6 (CCPA 1977).

Examiner's response seems improper because as stated above, routine optimization requires that the prior art first establish the importance of this variable. The cited references do not teach or suggest this weight ratio parameter as a significant parameter in providing the stabilized compositions of the claimed subject matter.

It is also an improper rationale because it suggests that there cannot be more than one patentable stabilized emulsion. By stating that *the recognized result in the case is the stability of the emulsion* implies that any composition that achieves this result would be non-patentable over the references. More important, the statement seems to not give the rule of *Antonie* its proper weight in overcoming the rejection.

In the office action of 12 March 2003, paper 18, Examiner explicitly indicated that selecting components would be routine optimization requiring simple experiments. If we assume, for arguments sake, that these experiments would be "simple" as Examiner states, that in itself would be irrelevant to an obviousness analysis. The mere fact that references can be combined or modified does not render the resultant combination obvious unless the prior art also suggests the desirability of the combination. *In re Mills*, 916 F.2d 680, 16 USPQ2d 1430 (Fed. Cir. 1990). MPEP § 2143.01. Thus, to maintain the rejection, the newly added claim limitation relating to the specific weight ratios must be suggested by the art. It is insufficient for a rejection under § 103 to use the claims as a menu for picking and choosing claim elements from the references, in hindsight.

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In the present case, the prior art does not teach or suggest the parameter added to the amended claims. In fact, Aronson does not disclose the use of fatty alcohols or mixed neutralized glyceryl esters at all. See office action of 12 March 2003, paper 18. In view of these omissions, it is not reasonable to suggest that Aronson's disclosure, individually or in combination with Jackman and Schneider, can render the instantly claimed stabilized emulsion obvious.

The Claimed Composition is Different than Aronson's

In the office action of 12 March 2003, Examiner dismissed the inclusion of fatty alcohols as reciting a surfactant falling within Aronson's disclosure. Examiner relied on col. 6, lines 1-7 wherein Aronson essentially asserts that any surfactants are encompassed in his invention, as long as they have the ability to stabilize an emulsion.

However, Aronson limits his disclosure of surfactants to non-ionic surfactants having an HLB of 1 to 7. The attached pages from EMULSIONS AND SOLUBILIZATION clearly point out that the fatty alcohols encompassed by the claimed subject matter have HLB values in emulsions of 14 or more. This is clearly not within the scope of Aronson's disclosure.

Thus, regardless of Aronson's attempt to encompass every surfactant that may be compatible with his stabilized emulsion, it is clear that he does not conceive of using, nor does he disclose the desirability of adding fatty alcohols. In fact, his specific criteria for nonionic surfactants clearly do not encompass fatty alcohols – they are omitted from the surfactants listed in the table of column 5.

For these reasons the rejections should be withdrawn.

CONCLUSION

In view of the foregoing remarks and amendments, favorable consideration of the application is respectfully requested.

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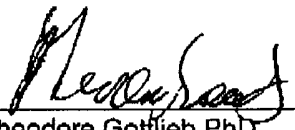
The claims have been amended to require a specific range of weight ratio. This parameter is disclosed in the specification as being of significance and therefore, is not new matter. The references do not teach or suggest this parameter as the references disclose all do not disclose any quantitative relationships of these components. Therefore, the limitation is not disclosed in the art.

Further, fatty alcohols are disclosed as having a specific quantitative relationship to the claimed stabilized emulsion. Fatty alcohols also have a HLB far greater than the upper limit set by Aronson. Accordingly, this claim element further patentably distinguishes the claimed subject matter from the references.

In view of the amendments and remarks, the rejections should be withdrawn and the claims allowed.

Respectfully Submitted,

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